

## **REMARKS**

Claims 3-6, 10-27 have been rejected by the Final Office Action dated February 22, 1998 ("Final Office Action"). Claims 1-2 and 7-9 were previously cancelled. Applicants request reconsideration because (1) the Final Office Action improperly rejected claims based on old claim language and (2) the Final Office Action was based its rejection on the Examiner's personal knowledge that was not in the record. Moreover, the claims should be in condition for allowance based on the arguments presented below.

### **I. Request For Reconsideration Based On Deficiencies of Office Action**

#### **A. Claims Improperly Rejected Because Rejection Was Based On Old Claim Language**

37 C.F.R. § 1.104 (b) states that "[t]he examiner's action will be complete as to all matters" The Office Action must consider the information submitted with the applicant's reply and apply the information as the examiner deems appropriate. M.P.E.P. § 704.14(b). Moreover, in a response to a non-final office action, Applicants are entitled to have properly amended claims entered and considered. 35 U.S.C. § 132; 37 C.F.R §§ 1.111. Also, 37 C.F.R § 1.104 (c) refers to rejections of the "claims", which are clearly the claims as entered. "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command." 37 C.F.R § 1.104 (c)(2) (emphasis added).

#### **1. Improper Rejections Under 35 U.S.C. § 112**

In the present case, the Final Office Action did not consider Applicants remarks with respect to the rejections under 35 U.S.C. § 112. The Final Office Action merely stated that Applicants' arguments were moot in view of the new ground(s) of rejection.

However, the grounds for rejections of Claims 3 and 10 under 35 U.S.C. § 112 were a verbatim copy of the rejection previously presented in the Non-Final Office Action dated July 27, 2007 (the "Non-Final Office Action"). See ¶ 2, p. 2 of Final Office Action and ¶ 2(b) of p. 3 of Non-Final Office Action. Clearly, this rejection was not a new ground of rejection.

Moreover, the Final Office Action did not address the claims as amended and entered in its 35 U.S.C. § 112 rejection. The Final Office Action rejected claims 3, 10, 18, and 25 under 35 U.S.C. § 112 because of the use of the term/phrase "the modular personal network is

about the same size as the user's personal space." However, the term/phrase was in the claim language of claims 3 and 10 prior to amendment, and not the claims as amended and entered. It is unclear if this was a clerical error or whether the Office Action was rejecting the claims based on old claim language. Moreover, the term/phrase does not appear in claims 18, or 25. At least for this reason, Applicants respectfully request that another Office Action be issued that specifically considers the arguments as presented and the claims as amended and entered.

## 2. Improper Rejections Under 35 U.S.C. § 103(a)

The Final Office Action did not address the claims as amended and entered in its 35 U.S.C. § 103(a) rejections. Specifically, the Office Action rejected claims 3 and 10 under 35 U.S.C. § 103(a) because, according to the Office Action, Anderson teaches "a single network component can be removed resulting in an operating modular personal network that can perform without *the network* component and its corresponding one or more functions." See Final Office Action ¶ 3, p. 6. However, this is not the language in the claims 3 and 10 as entered and amended.

Applicants note that Applicants appear to inadvertently recite this old language in their arguments in the Amendment and Response dated November 27, 2007. But this is not an admission by Applicants that the amended language is the same as the previously claimed language. More importantly, the Final Office Action should consider the language as recited in claims as amended and entered.

Because the Final Office Action did not reject the "claims" as amended and entered as required by 37 C.F.R. §§ 1.104 (c)(2) , 1.111 and the Final Office Action was not complete as to all matters. See 37 C.F.R. § 1.104 (b). Applicants respectfully request that another Office Action be issued that specifically considers the arguments as presented and the claims as amended and entered.

B. Personal Knowledge of the Term "Modular Personal Network" Must Be Made Of Record When Used In Office Action Rejection

The relevant rules state that "[i]n rejecting claims the examiner may rely upon admissions by the applicant ... as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section." 37 C.F.R. § 1.104(c)(3). But, § 1.104 (d)(2) requires that "[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible." The rules also require that "[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office." 37 C.F.R. § 1.2. More specifically, M.P.E.P. § 713.04 requires that the substance of an interview must be made of record.

Here, during an interview held with the Examiner on May 7, 2007, the Examiner indicated that his understanding of the term "modular personal network" on which he based his rejection was derived from a prior telephone interview with the Applicants. However, nothing in the record suggests that the parties discussed the meaning of the term "module personal network" in a prior interview.

There was a prior a Telephone Interview conducted on July 6, 2006. But, the Interview Summary form PTOL-413 of the interview merely stated that "Applicant's representative discussed possible amendments to the limitations of claims 3 and 10. Examiner would consider the amendments and applicant's remarks when submitted officially." Also, Applicants' Amendment dated September 29, 2006 stated that the parties discussed "claim 3 and the cited references, Willard and Singer ... Applicants traversed the rejections by at least pointing out that Willard and Singer do not describe or suggest the below mentioned features of claim 3." The Examiner never objected to Applicants' summary of the September 29, 2006 interview to "correct material inaccuracies which bear directly on the question of patentability." See M.P.E.P. § 713.04.

Any information gleaned by the Examiner in the Telephone Interview conducted on July 6, 2006 that is not made of record but that is used in the rejection in the Final Office Action is personal knowledge. See 37 C.F.R. § 1.104(c)(3). Accordingly, this personal knowledge basis for the rejections must be specifically detailed in the Final Office Action. See 37 C.F.R. §§ 1.104(c)(3) and 1.104 (d)(2). Applicants respectfully request that another Office

Action be issued that specifically states the Examiner's personal knowledge of the meaning of the term "modular personal network" and how it is used in the rejections.

## **II. Rejection under 35 U.S.C. § 112**

Claims 3 and 10 have been rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as required under 35 U.S.C. § 112, second paragraph. Specifically, it is asserted by the Examiner that "the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The actual size of the user's personal space is not clearly defined in the specification." Final Office Action p 2.

Applicant respectfully disagrees. Those of ordinary skill in the art will understand the meaning of the phrase in question, which now as amended reads "the modular personal network is about the size as a user's personal space." The phrase indicates, to those of ordinary skill in the art, an expected range for the network that would at least encompass the size of individual users' personal space taking into account variations in the personal dimensions of individuals, which is well known in the public. The phrase, however, does not require of the scope of the claim to indicate that in the claimed invention the range is relative to whoever is the current user, which appears to be the Examiner's objection.

In view of the foregoing, Applicants respectfully request the withdrawal of the rejections of claims 3 and 10 as not compliance with indefinite requirement under 35 U.S.C § 112, second paragraph.

## **III. Rejection under 35 U.S.C. § 103**

Claims 3-5, 10-12, and 14-27 are rejected under 35 USC § 103(a) as being unpatentable over Kivela et al (US 6,272,359) (hereinafter Kivela) in view of Anderson (US 6,594,370), (hereinafter Anderson). Applicants note that the basis for these rejections are substantially the same as the rejection from the Non-Final Office Action of July 27, 2007. The only differences that Applicants can discern is that for the claims 3 and 10 rejections, is that the Final Office Action added citations from Kivela at col. 15, line 20- col. 16, line 23, Fig. 8 and the Abstract. The added citations are directed to Fig. 8, but is unclear how the added citations

specifically discloses the elements of the claims. For example, Fig. 8 and the accompanying description only shows devices in communication in a GSM network. See e.g., Kivela 15:20-30. But, Fig. 8 does not disclose a modular personal network ("MPN" as recited in the claims and discussed further below) nor the size of the devices or their network in relation to a user's personal space.

Moreover, as discussed in the prior response to the Non-Final Office Action, all the features of claims 3 through 6 and 10 through 13 are not described or suggested by Kivela and Anderson, individually or in combination. For example, Kivela and Anderson do not describe or suggest the recited characteristics of the claimed jewelry individual network component of claim 2 or as recited in the method of claim 10, which states the component is configured to operate in a modular personal network, where, among other things, the MPN is a network in which a new network component can be added to the modular personal network at any time to increase the capabilities of the system, a single network component can be removed resulting in an operating modular personal network that can perform without the single network component and its corresponding one or more functions. Examiner relies on Kivela in view of Anderson to assert that the present claims are obvious. Kivela, the primary reference, is directed to a mobile communication device that is constructed for use in communicating with a wireless communications network. Kivela is intended as a distributed mobile communication transceiver device. The Examiner concedes that Kivela fails to describe "a new network component can be added to the modular personal network at any time to increase the capabilities of the system," and "a single network component can be removed resulting in an operating modular personal network that can perform without that network component and its corresponding one or more functions". Final Office Action, p. 6. Anderson does not overcome Kivela's deficiencies, Kivela and Anderson, either alone or in combination or make obvious, does not anticipate claims 3 and 10 for at least following reasons.

Anderson is directed to a personal communication system which includes ear piece and RPU (remote processor unit). RPU allows two way communications with the ear piece and allows earpiece operating power to be beamed from the RPU. This results in size and cost reductions in both the earpiece and RPU allowing the manufacture of disposable hearing aids and when the RPU is equipped with secondary wireless link circuitry, cellular telephones and pagers. *Abstract*. The necklace is preferably in the form of a flexprint, the necklace is fastened in front

with a snap to facilitate easy removal. Once removed from the user's neck, the electronic components within the flexprint strip may be programmed and tested, and batteries recharged. *Col. 4, lines 43 through 47.* The necklace further supplies power to the ear piece through virtual battery wherein the 1.8 milliwatts of continuous power can be produced by the "virtual battery" system for powering the ear piece. *Col. 5, lines 53 through 60.*

Anderson fails disclose or suggest the ability to add a new network component to the modular personal network at any time to increase the capabilities of the system. In particular, Anderson discloses a RPU unit, which is the central piece for Anderson's system. The RPU provides power and bi-directional communications capabilities to the ear piece. *Col. 4, lines 24 through 35.* The RPU further supplies communications to other devices such as a wrist watch. *Col. 3, lines 64 through 68.* However, Anderson is silent on the timing of adding or removing any of these components. Specifically, there are times when RPU is taken off of the user for maintenance, programming, and charging batteries. *Col. 4, lines 43 through 48.* Since the devices such as the wrist watch communicate with the RPU, the communications function is no longer in operation once the RPU is taken off line. Therefore, the addition of external wireless devices may not be added to the modular personal network at any time. Moreover, the complexity of the network in Anderson is heavily dependent upon RPU and requires RPU to be programmed and maintained as additional devices is attached to the network. Significantly, the external devices will only work when external batteries are attached to the RPU. *Col. 3, lines 43 through 52.* The attachment of new batteries require removal of a flexprint and further programming and maintenance on the RPU, such as recharging and adding new batteries. Accordingly, secondary wireless link circuitry may not be added at any time without particular configuration of RPU unit.

More significantly, the ear piece themselves depends upon the RPU for communications and power. *Col. 4, lines 30 through 35; Col. 5, lines 53 through 60.* Anderson discusses the removal of a particular component, namely the RPU for maintenance and programming, it fails to disclose or suggest that ear pieces and secondary wireless link circuitry maybe added at any time. Since RPU provides wireless communication means for secondary wireless devices and the earpiece, the removal of RPU will stop the operation of the entire wireless network thereby detrimentally effect the operation of the network in Anderson. As such, Anderson fails to disclose, suggest or otherwise provide for "a new network component

can be added to the modular personal network at any time to increase the capabilities of the system, a single network component can be removed resulting in an operating modular personal network that can perform without *the single* network component and its corresponding one or more functions", as recited in the claims 3 and 10.

Therefore, based on the foregoing, withdrawal of the rejection of claim 3 is respectfully requested. Independent claim 10 is also allowable at least on the basis of some of the reasons provided above for claim 3. Dependent claims 4-6 and 11-13, which depend from claims 3, and 10, respectively, are also allowable at least on the basis of being dependent from independent claims 3 and 10. Allowance of claims 14-27 are also requested.

In view of the above remarks, the applicants respectfully request withdrawal of the 35 U.S.C. 103(a) rejections. The application is now believed to be in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree or have any questions, then a personal or telephonic interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application.

Respectfully submitted,

Date

6/23/08

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